

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on June 26, 2006, the Examiner rejected claims 1-24 under 35 U.S.C. 103(a) as being unpatentable over Hey et al (United States Patent No. 4,987,856, hereinafter "Hey"), and rejected claims 1-24 under 35 U.S.C. 103(a) as being unpatentable over Toshima (United States Patent No. 4,785,962, hereinafter "Toshima"). Applicant expresses appreciation for the Examiner's Interview that was conducted on September 6, 2006, respectfully submits that the cited references do not make obvious the claims provided herein, and respectfully provides the following:

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention. In particular, independent base claim 1 recites a method for applying a coating to a surface of an item, said method comprising: providing a die having a cavity and an aperture, said aperture having a collection surface and a parallel surface; providing a substantially rigid item for coating, wherein a cross-sectional configuration of said item corresponds to a cross-sectional configuration of said aperture of said die; feeding a coating material into said cavity of said die; using said collection surface as a receiving channel that collects said coating material in said cavity for application onto a surface of said item; and applying said coating material to said surface of said item by passing said item

through said cavity and said aperture of said die, wherein said parallel surface is parallel to said surface of said item. Such limitations in independent base claim 1 are supported by the application as originally filed. For example, reference is made to Figures 2, 5 and 6.

In contrast, none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations as recited in independent claim 1. And, since the references cited by the Examiner do not teach or suggest each and every limitation of independent base claim 1, Applicant respectfully submits that the cited references do not make obvious independent base claim 1 as provided herein. And, since the prior art references do not make obvious independent base claim 1, Applicant respectfully submits that the cited references do not make obvious the corresponding dependent claims that depend from independent base claim 1.

Independent base claim 14 recites a method for applying a coating material to one or more of a plurality of items in series, said method comprising: providing a two-part die having a cavity and an aperture, said aperture having a collection surface and a parallel surface; providing a non-continuous, substantially rigid item for coating, wherein a cross-sectional configuration of said item corresponds to a cross-sectional configuration of said aperture of said die; feeding a coating material into said cavity of said die; using said collection surface as a receiving channel that collects said coating material in said cavity for application onto a surface of said item; and applying said coating material to said surface of said item by passing said item through said cavity and said aperture of said die, wherein said parallel surface is parallel to said surface of said item. Such limitations in independent base claim 1 are supported by the application as originally filed.

In contrast, none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations as recited in independent claim 14. And, since the

references cited by the Examiner do not teach or suggest each and every limitation of independent base claim 14, Applicant respectfully submits that the cited references do not make obvious independent base claim 14 as provided herein. And, since the prior art references do not make obvious independent base claim 14, Applicant respectfully submits that the cited references do not make obvious the corresponding dependent claims that depend from independent base claim 14.

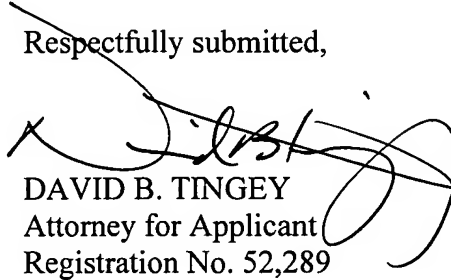
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 26th day of December, 2006.

Respectfully submitted,



DAVID B. TINGEY
Attorney for Applicant
Registration No. 52,289

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 323-5986
Facsimile: (801) 321-4893

DBT:cdl
922826.1



Title: METHOD AND APPRATUS FOR EXTRUDING
A COATING UPON A SUBSTRATE SURFACE

Inventors: Kendall W. Prince et al
Serial Number 10/723,500

ANNOTATED SHEET SHOWING CHANGES

1/10

Header, sheet number,
and total sheet number
added

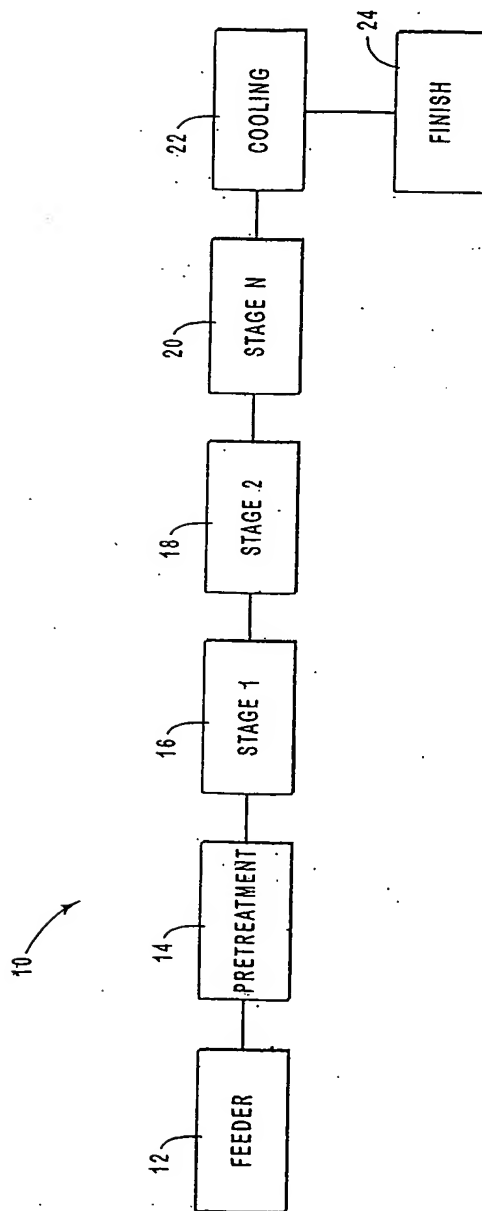


FIG. 1

ANNOTATED SHEET SHOWING CHANGES

2/10

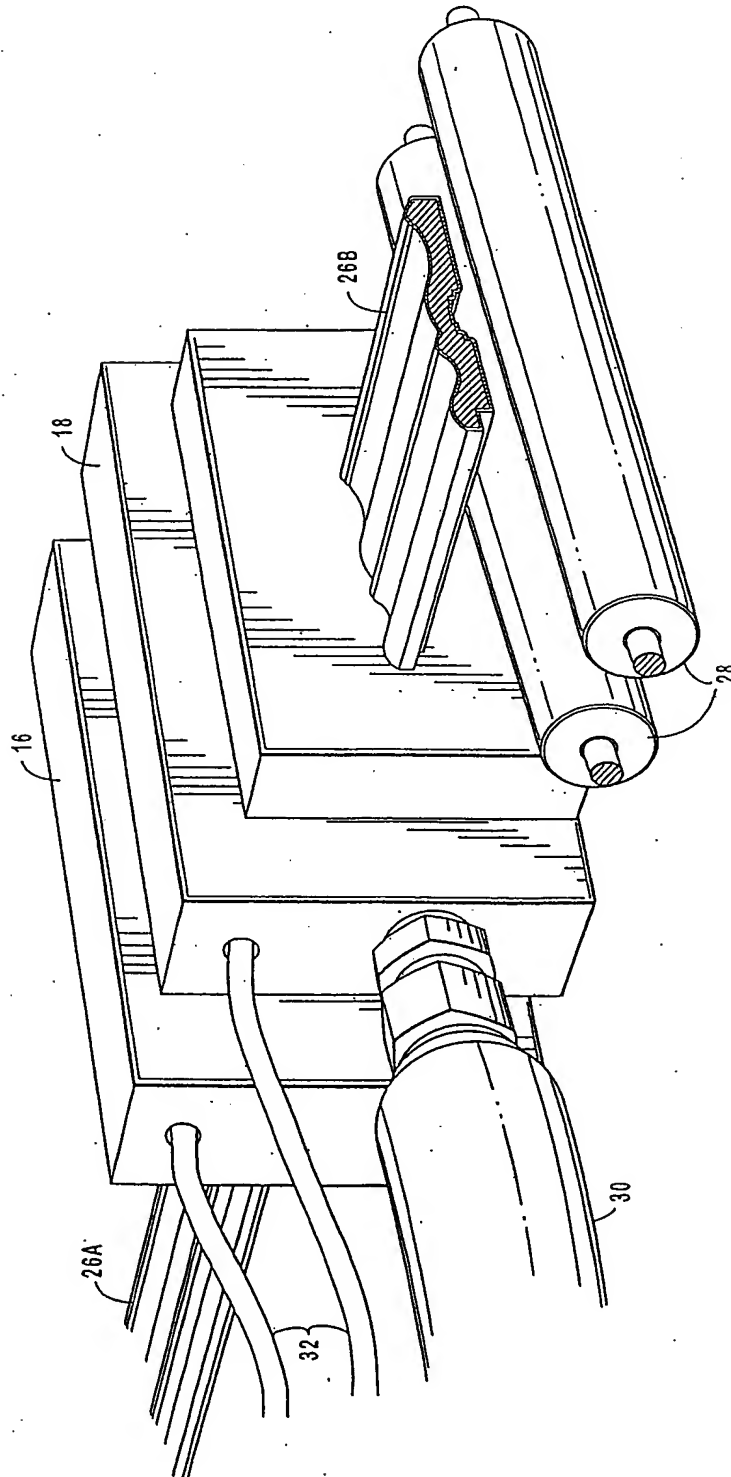


FIG. 2

ANNOTATED SHEET SHOWING CHANGES

3/10

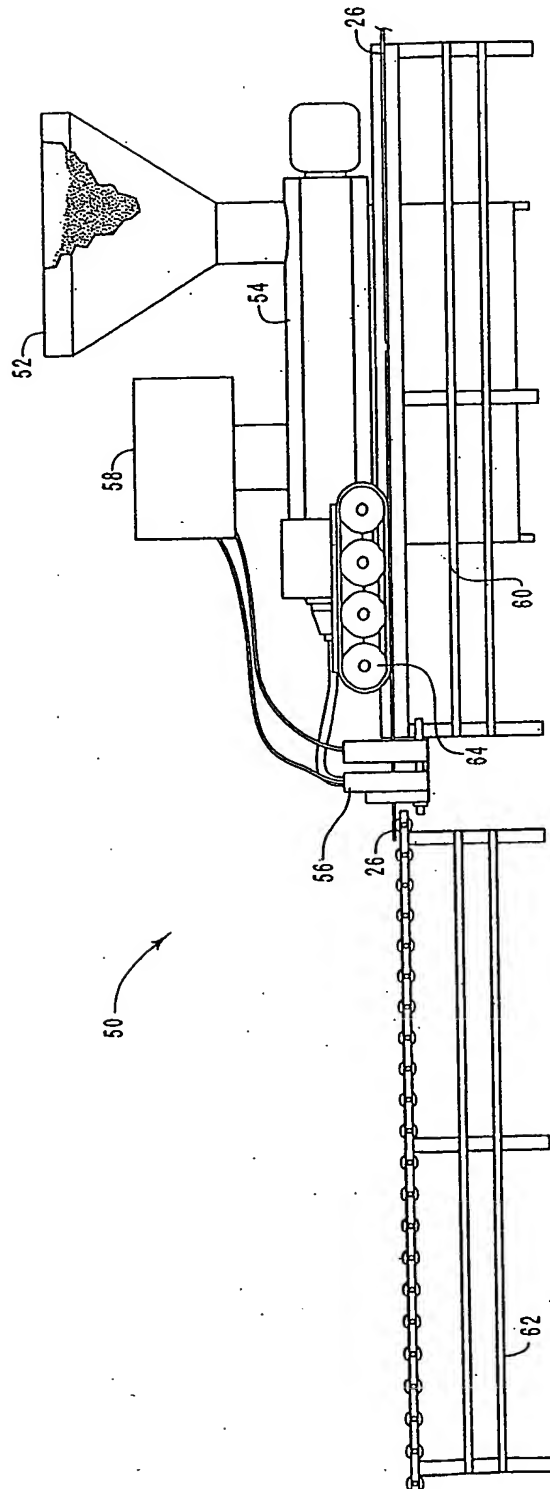
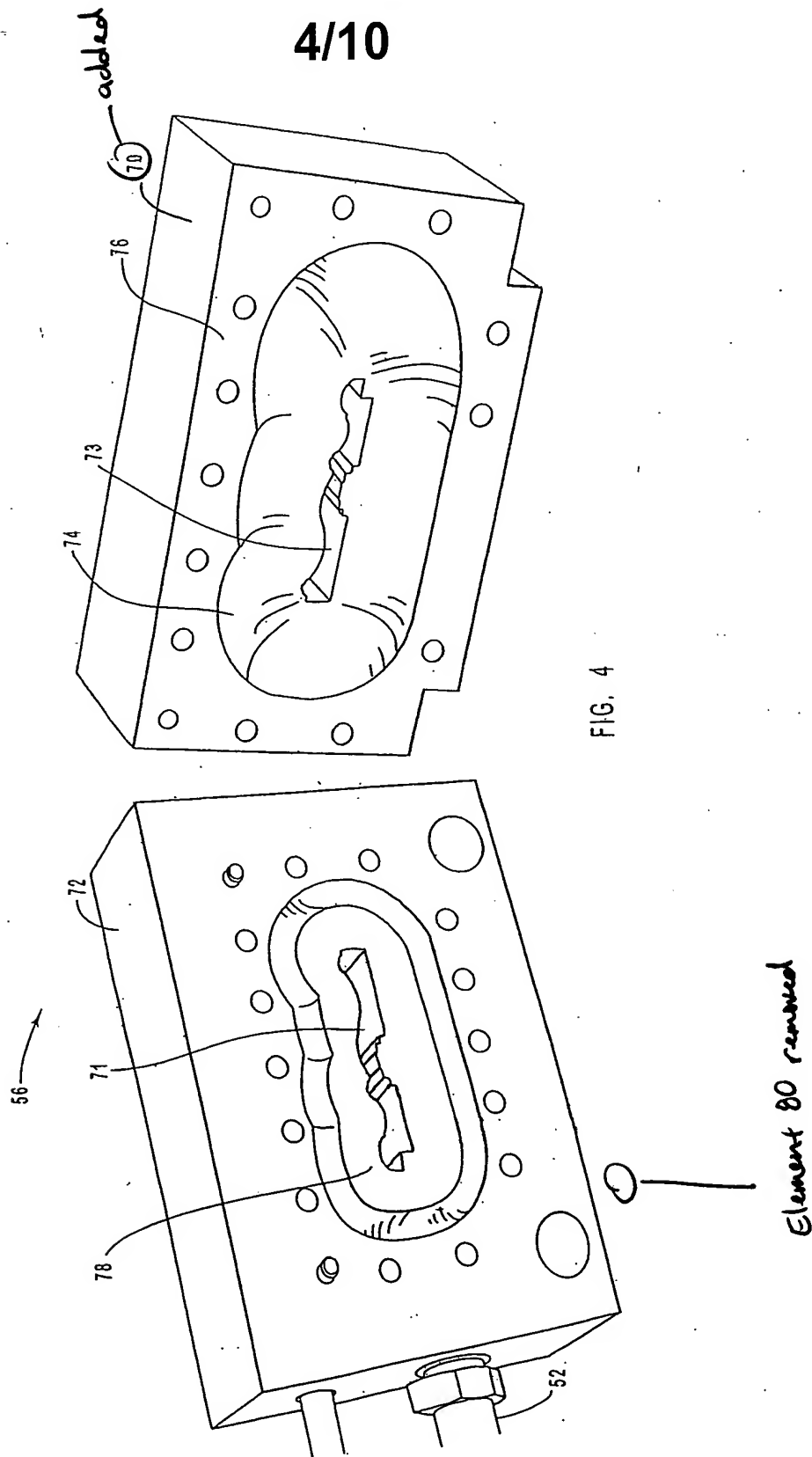


FIG. 3

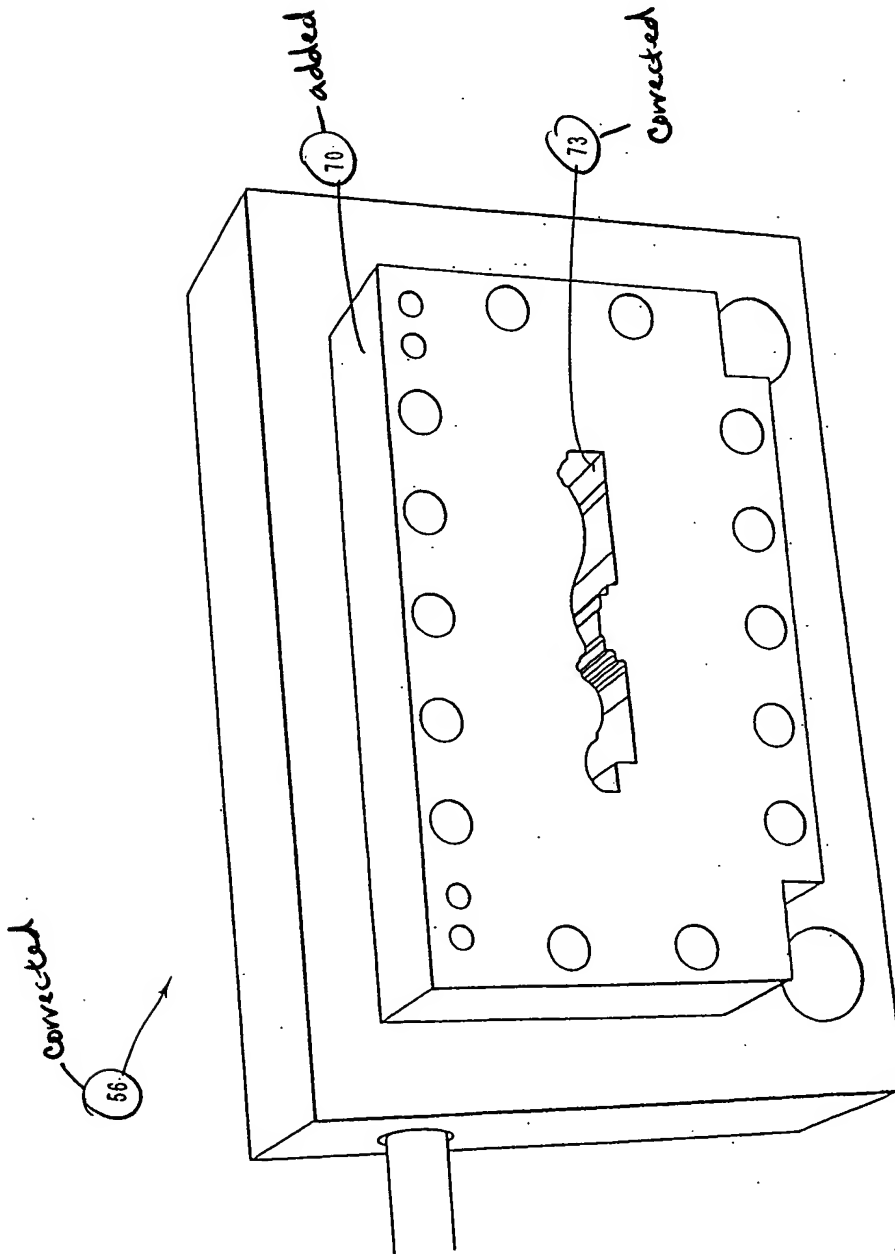
ANNOTATED SHEET SHOWING CHANGES

4/10



ANNOTATED SHEET SHOWING CHANGES

5/10



ANNOTATED SHEET SHOWING CHANGES

6/10

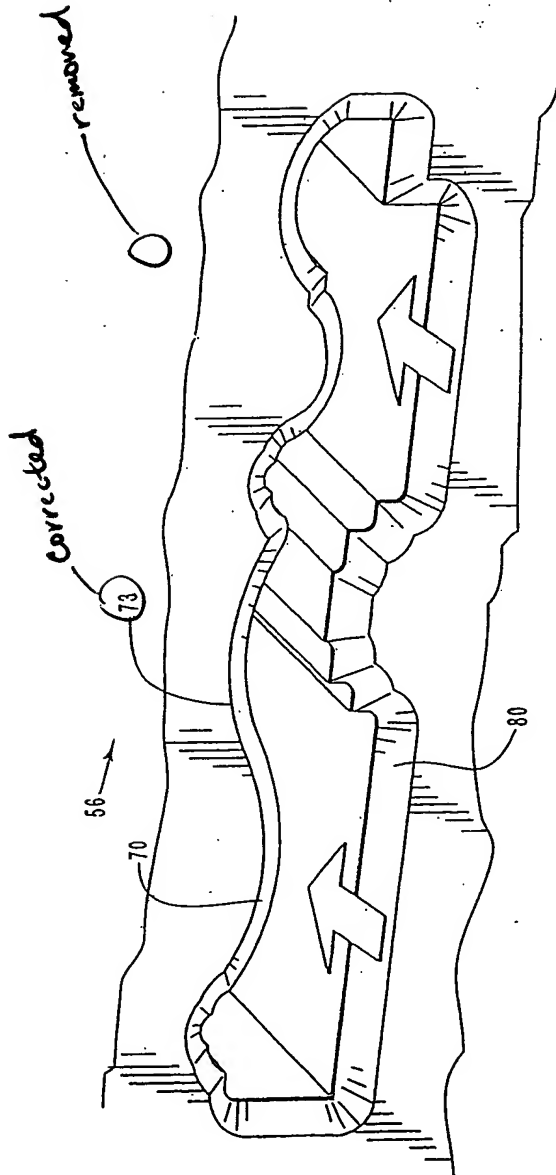


FIG. 6

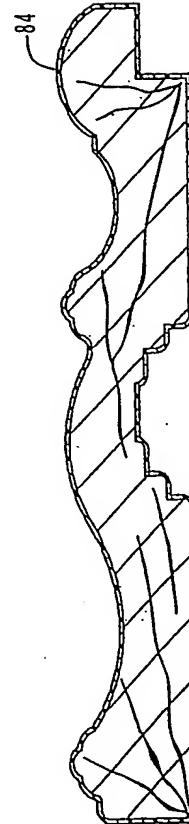


FIG. 7

ANNOTATED SHEET SHOWING CHANGES

7/10

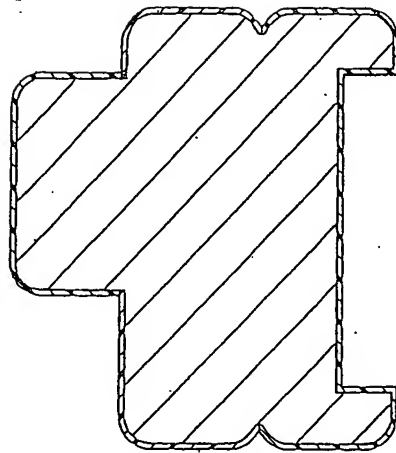


FIG. 8C

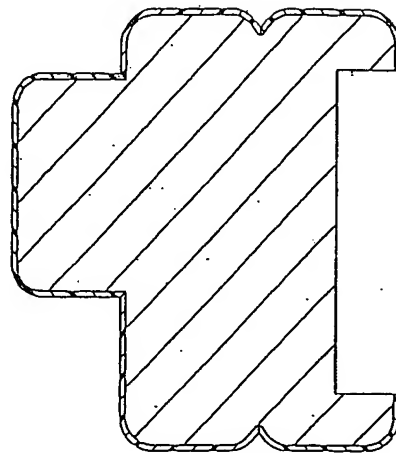


FIG. 8D

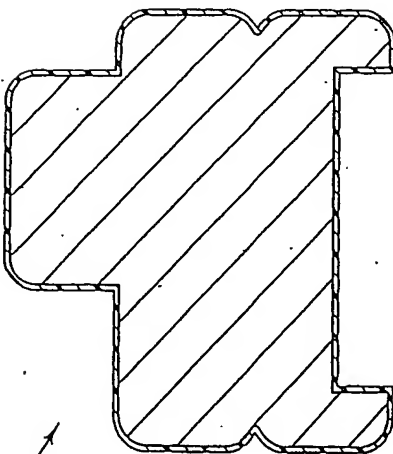


FIG. 8A

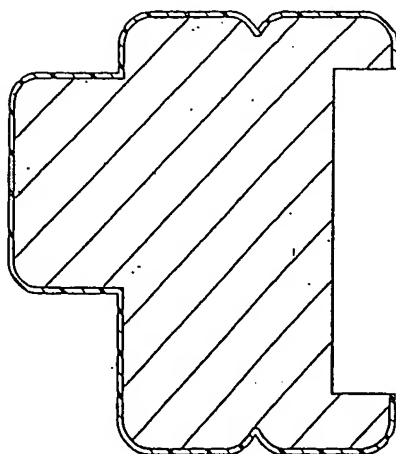
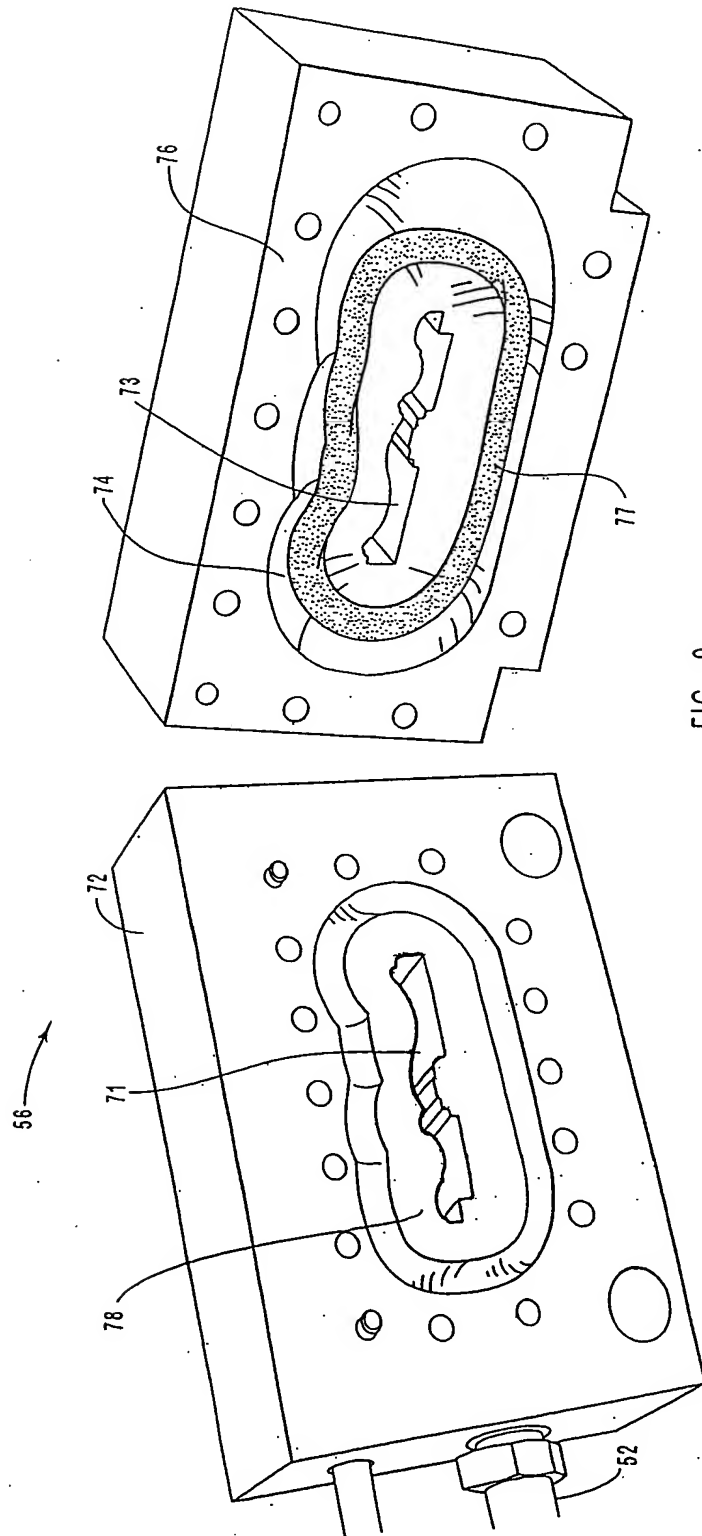


FIG. 8B

16

ANNOTATED SHEET SHOWING CHANGES

8/10



ANNOTATED SHEET SHOWING CHANGES

9/10

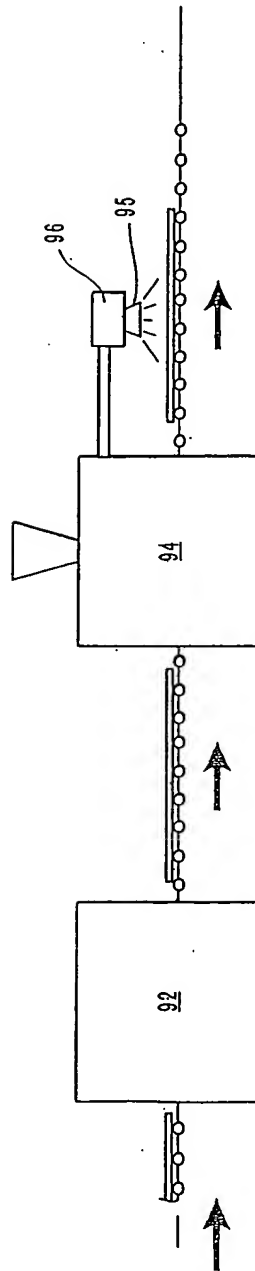


FIG. 10

ANNOTATED SHEET SHOWING CHANGES

10/10

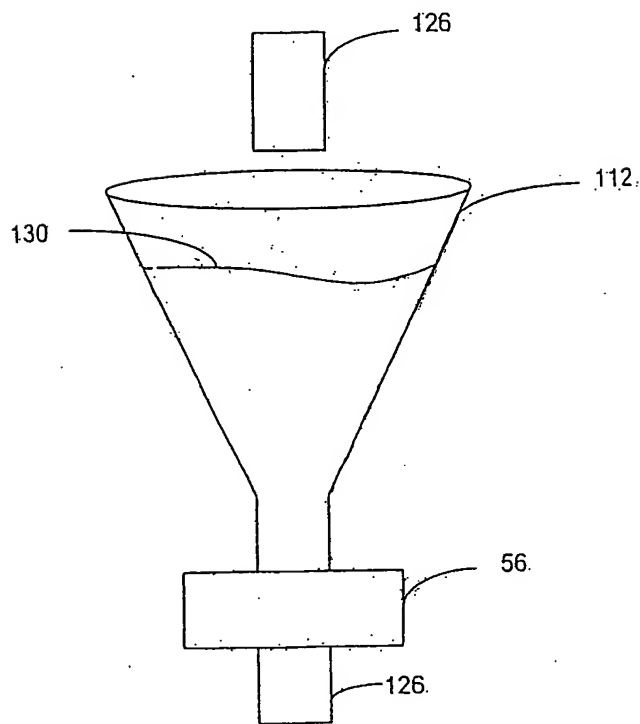


FIG. 11

Corrected